IN THE UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

DEXTER-RUSSELL, INC. Plaintiff, v. **MERCER TOOL CORP. d/b/a MERCER CULINARY,** Defendant.	**Case No.: 17-cv-1128** ECF Case **Jury trial demanded**

COMPLAINT

Plaintiff, Dexter-Russel, Inc. ("Dexter"), by and through its attorneys, Lackenbach Siegel LLP, for its complaint against Mercer, Mercer Tool Corp. d/b/a Mercer Culinary ("Mercer" or "Mercer"), hereby alleges as follows:

NATURE OF ACTION

1. In this action, Dexter seeks injunctive relief, lost profits, damages and attorneys' fees for Mercer's acts of willful trademark infringement, false designation of origin, false descriptions, and unfair competition, pursuant to the Lanham Act, 15 U.S.C. § 1051 *et seq.*, and trademark infringement and dilution, deceptive acts and practices, injury to business reputation and dilution, and unfair competition under the common law and statutes of the State of New York.

JURISDICTION AND VENUE

2. This Court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338, and 1367.

3. The actions of Mercer complained of in this Complaint have been and continue to be committed within the Southern District of New York.

4. Upon information and belief, Mercer is a corporation organized and existing under the laws of the State of New York, with its principal place of business in Ronkonkoma, New York, within this judicial district.

5. Upon information and belief, Mercer resides, contracts to supply goods and/or services, and/or transacts business in New York and within this judicial district; and the tortious acts of Mercer complained of in this Complaint, including, without limitation, the willful and illegitimate use Dexter's trademarks and goodwill have caused harm to Dexter within this judicial district. Accordingly, personal jurisdiction exists over Mercer pursuant to CPLR §§ 301 and 302.

6. Venue is proper in this district pursuant to 28 U.S.C. § 1391.

THE PARTIES

7. Plaintiff Dexter is a corporation organized and existing under the laws of the State of Massachusetts, having its principal place of business at 44 River Street, Southbridge, Massachusetts 01550.

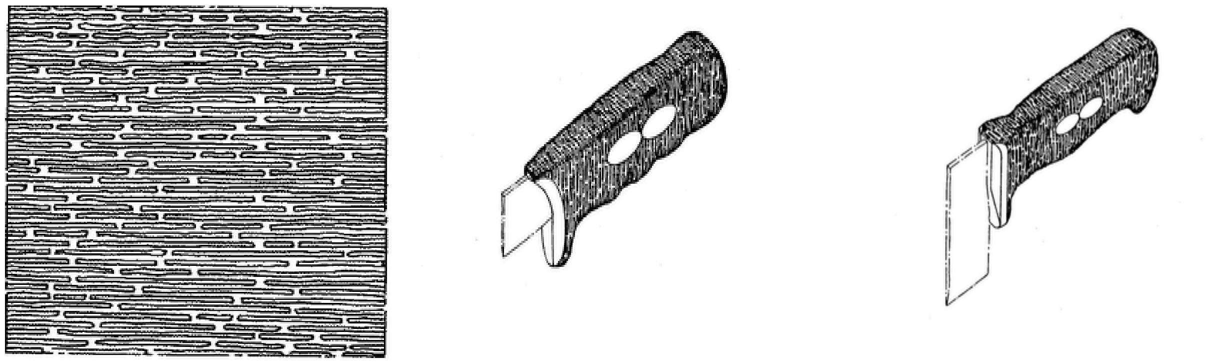
8. Upon information and belief, Mercer is a corporation organized and existing under the laws of the State of New York, having its principal place of business at 1860 Smithtown Ave, Ronkonkoma, NY 11779.

FACTUAL ALLEGATIONS

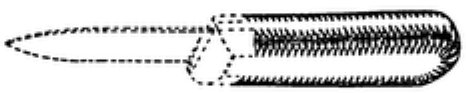
9. Dexter is the largest manufacturer of professional cutlery and culinary products in the United States, and has been operating and selling such products in interstate commerce since as early as 1933.

10. Dexter has adopted and used, and is the owner of many trademarks, slogans, and logos in connection with its products, including, without limitation, the ornamental shapes and looks of certain handles used on its cutlery products ("Dexter Handles").

11. Specifically, Dexter owns a trademark that is a surface ornamentation consisting of multiple, elongated, wavy shapes formed on the surface of the handle, as depicted here (the "Wavy Line Mark"):



12. Dexter also owns a trademark in the shape of a Dexter Handle that consists of a diamond shaped pattern formed on the surface of the handle, as depicted here ("Diamond Handle Mark"):



13. The Wavy Line Mark and the Diamond Handle Mark may be collectively referred to as the "Trademarks."

14. Dexter is the owner of numerous US Trademark Registrations with respect to its Trademarks. Dexter is the owner of United States Trademark Registration No.1493915 for the Diamond Handle Mark, and United States Trademark Registrations Nos. 1852215, 1856552 and 3044256 for the Wavy Line Mark (collectively, the "Registrations").

15. Dexter uses its Trademarks in connection with, knives, cutlery, plastic handled paring, clam and scallop knives, forks, spatulas, and poultry stickers and pinners (collectively the "Dexter Goods").

16. The Trademarks have been used openly, notoriously, and continuously on the Dexter Goods in interstate commerce since their respective dates of first use as set forth in the Registrations, all times prior to any of the acts of Mercer complained of herein.

17. Each of the Trademarks is an inherently distinctive and strong trademark.

18. Each of the Registrations is incontestable.

19. Dexter has advertised and otherwise promoted its Trademarks in connection with the Dexter Goods extensively since making first use of the Trademarks, through traditional marketing, social media outlets and other means.

20. Dexter's products and services, including the Dexter Goods, bearing the Trademarks have been the subject of unsolicited media coverage.

21. Because of Dexter's extensive use and promotion of the Trademarks, and in light of the unsolicited media coverage and notoriety pertaining to the Dexter Goods and the Trademarks, the Trademarks have become distinctive and prominent, and indicate a single

source of origin of Dexter's goods and services, including the Dexter Goods, and have acquired a secondary meaning.

22. By virtue of Dexter's use, advertising, promotion and sales of the Dexter Goods in connection with the Trademarks, and the unsolicited media coverage featuring the Trademarks, the Trademarks have become associated with Dexter and have created an association between Dexter and its Trademarks in the mind of consumers.

23. Upon information and belief, Mercer manufactures, markets, advertises, offers for sale and sells cutlery and other culinary products.

24. In or about 2004, Mercer manufactured, marketed, advertised, offered for sale and sold certain cutlery and culinary products featuring a handle design that was confusingly similar to the Trademarks (the "Previous Infringing Products").

25. In or about 2004, Dexter contacted Mercer and informed Mercer that the Previous Infringing Products were confusingly similar to the Trademarks and thus infringed the Trademarks.

26. On or about September 2, 2004, Dexter and Mercer resolved the dispute by entering into a written settlement agreement (the "2004 Agreement").

27. The 2004 Agreement obligated Mercer to abandon and permanently cease all use and advertising the Previous Infringing Products, and granted Mercer a sell-off period for the Previous Infringing Products.

28. As part of the 2004 Agreement, Mercer acknowledged Dexter's rights in and to the Wavy Line Mark registered in Dexter's Registration Nos. 1856552 and 1852215.

29. Since the 2004 Agreement, Mercer has had actual knowledge of Dexter, Dexter's use of the Trademarks, and Dexter's ownership of Registration Nos. 1856552 and 1852215 for the Wavy Line Mark.

30. Dexter has recently become aware of certain new Mercer products, including Mercer's Boston Style and New Haven Style Oyster Knives, and Clam Knife, bearing the respective product numbers M33027, M33028, M33029 and M33026 (the "Infringing Products").

31. Upon information and belief, Mercer manufactures, markets, advertises, offers for sale and sells the Infringing Products in interstate commerce within the United States.

32. The Infringing Products feature ornamental handle designs that are identical and/or strikingly and confusingly similar to the Trademarks (the "Infringing Handle Designs").

33. Mercer's Infringing Handle Designs and Infringing Products are confusingly similar to the Trademarks.

34. Dexter and Mercer are engaged in the business of providing similar products to the same class of customers, through the same or similar channels of trade.

35. Upon information and belief, Mercer was aware of Dexter and Dexter's use of the Trademarks, and Dexter's ownership of its Registration Nos. 1856552 and 1852215 for the Wavy Line Mark, at the time Mercer adopted and began to market, offer for sale and sell the Infringing Products.

36. Upon information and belief, Mercer adopted its Infringing Handle Designs with the intent to deceive consumers and to cause confusion among purchasers, for the purpose of benefitting from the good will and public recognition associated with Dexter's Trademarks and diverting sales from Dexter to Mercer.

37. Given the circumstances, including Mercer's knowledge of Dexter, the proximity of the parties' respective goods, and the striking and confusing similarity between the Trademarks and the Infringing Handle Designs, it is apparent that Mercer selected, adopted, and is offering for sale and selling the Infringing Products with the specific intent of creating and causing confusion with Dexter, thereby illicitly benefiting from Dexter's reputation and good will, and diverting sales from Dexter to Mercer.

38. The aforementioned acts of Mercer have caused and will continue to cause a likelihood of confusion in the minds of the trade and the public, and will damage Dexter's reputation and good will in connection with its Trademarks.

COUNT I
REGISTERED TRADEMARK INFRINGEMENT (LANHAM ACT § 32)

39. Dexter repeats and realleges each and every allegation contained in the prior paragraphs hereto, and the same are incorporated herein and made a part hereof.

40. The Registrations are valid, subsisting and incontestable.

41. Dexter's Trademarks are strong trademarks, based on both their inherent strength and their commercial strength.

42. Dexter's goods and services, including the Dexter Goods, are goods and services which are sold, distributed, furnished and/or advertised to the same or similar classes of purchasers as Mercer's goods and services, including the Infringing Products.

43. The Infringing Products, which feature the Infringing Handle Designs, are strikingly and confusingly similar to the Trademarks.

44. Mercer's advertising, marketing and offering for sale of the Infringing Products has created and creates a likelihood of confusion with Dexter, Dexter's registered Trademarks and/or the Dexter Goods.

45. Upon information and belief, Mercer was aware of Dexter, Dexter's use of its Trademarks and of Dexter's ownership of the Registrations, all prior to the time Mercer selected and adopted the Infringing Handle Designs, and commenced offering for sale and selling the Infringing Products.

46. Upon information and belief, based upon, without limitation, the striking and confusing similarity between the Trademarks and the Infringing Handle Designs, the proximity of the parties' respective goods, and Mercer's prior knowledge of Dexter, and its Registrations, and Dexter's use of its Trademarks, Mercer adopted, offered for sale and sold the Infringing Products with the intent of causing confusion among consumers and with the purpose of benefitting from Dexter's reputation and goodwill, constituting willful trademark infringement.

47. As a result of Mercer's conduct, a strong likelihood of confusion, mistake, and/or deception exists, and many persons familiar with Dexter's registered Trademarks, the Dexter Goods, and Dexter's reputation and favorable goodwill, are likely to buy Mercer's goods and/or services in belief that Mercer is affiliated with and/or sponsored by Dexter and/or that the Infringing Products sold by Mercer originate from Dexter or are provided by, or otherwise authorized or sponsored by, Dexter.

48. Mercer, accordingly, is engaged in the willful infringement of Dexter's registered Trademarks, in violation of the Lanham Act § 32, 15 U.S.C. § 1114(1), by using marks wherein such use is likely to cause confusion, or to cause mistake or deception.

49. Mercer intended to make, and has made, unlawful gains and profits from such unlawful infringement and, by reason thereof, Dexter has been and will be deprived of rights and profits which otherwise would have come to Dexter, but for such infringements.

50. Dexter has no adequate remedy at law for the injury alleged in this Count. The injury is intangible in nature and not capable of being fully measured or valued in terms of money damages. Further, the injury is of a continuing nature and will continue to be suffered so long as Mercer continues its wrongful conduct.

51. Mercer's acts are willful, malicious and wanton and Mercer will continue its acts of willful infringement unless enjoined by this Court.

52. Notwithstanding the inadequacy of, and the difficulties in fully ascertaining Dexter's monetary damages caused by Mercer's wrongful conduct, Dexter is informed and believes and, based upon such information and belief, alleges that said conduct has resulted in irreparable, direct and proximate damages to Dexter. Dexter seeks leave of this Court to amend its complaint to allege the full nature and extent of said monetary damages, if and when, and to the extent the damages are ascertained.

COUNT II
TRADEMARK INFRINGEMENT, FALSE DESIGNATION OF ORIGIN, FALSE DESCRIPTION, AND UNFAIR COMPETITION (LANHAM ACT § 43(a))

53. Dexter repeats and realleges each and every allegation contained in the prior paragraphs hereto, and the same are incorporated herein and made a part hereof.

54. The Trademarks are inherently distinctive.

55. The Trademarks have acquired distinctiveness and a secondary meaning.

56. The Trademarks are strong trademarks, based on both their inherent strength and their commercial strength.

57. Dexter's goods and services, including the Dexter Goods, are goods and services which are sold, distributed, furnished and/or advertised to the same or similar classes of purchasers as Mercer's goods and services, including the Infringing Products.

58. The Infringing Handle Designs are strikingly and confusingly similar to the Trademarks.

59. Mercer's marketing, advertising, offering for sale and sale of the Infringing Products creates a likelihood of confusion with Dexter, Dexter's Trademarks, and/or the Dexter Goods.

60. Upon information and belief, based upon, without limitation, the striking and confusing similarity between the Trademarks and the Infringing Handle Designs, the proximity of the parties' respective goods, and Mercer's prior knowledge of Dexter, its Registrations, and of Dexter's use of its Trademarks, Mercer adopted, offered for sale and sold the Infringing Products with the intent of causing confusion among consumers and with the purpose of benefitting from Dexter's reputation and goodwill, constituting willful trademark infringement.

61. As a result of Mercer's conduct, a strong likelihood of confusion, mistake, or deception exists, and many persons familiar with Dexter's Trademarks, the Dexter Goods and Dexter's reputation and favorable goodwill, are likely to buy Mercer's goods and/or services in belief that Mercer is affiliated with or sponsored by Dexter, and/or that the Infringing Products sold by Mercer originate from Dexter or are provided by or otherwise authorized or sponsored by Dexter.

62. The acts and conduct of Mercer are willful, unfair, and deceptive, in that they intend to mislead, deceive and confuse, and have had, and continue to have the result of misleading, deceiving and confusing the public to believe that Mercer and/or its Infringing Handle Designs and Infringing Products are affiliated with, or sponsored or controlled by Dexter. Mercer has thus attempted to trade upon, and gain public acceptance and other benefits from Dexter's favorable reputation, which favorable reputation has in turn, been placed at risk by Mercers' illegal acts and conduct.

63. The acts of Mercer constitute trademark infringement, false designations of origin, false representations, and unfair competition, by inducing the erroneous belief that Mercer and/or its Infringing Products are in some manner affiliated with, originate from, or are sponsored by Dexter, and by misrepresenting the nature and/or origin of Mercer's goods and services, all in violation of Lanham Act § 43(a), 15 U.S.C. § 1125(a).

64. Mercer intended to make, and has made, unlawful gains and profits from such unlawful infringement and, by reason thereof, Dexter has been and will be deprived of rights and profits which otherwise would have come to Dexter but for such infringements.

65. Dexter has no adequate remedy at law for the injury alleged in this Count. The injury is intangible in nature and not capable of being fully measured or valued in terms of money damages. Further, the injury is of a continuing nature and will continue to be suffered so long as Mercer continues its wrongful conduct.

66. Mercer's acts are and have been willful, malicious and wanton, and Mercer will continue its acts of willful infringement unless enjoined by this Court.

67. Notwithstanding the inadequacy of, and the difficulties in fully ascertaining Dexter's monetary damages caused by Mercer's wrongful conduct, Dexter is informed and

believes and, based upon such information and belief, alleges that said conduct has resulted in irreparable, direct and proximate damages to Dexter. Dexter seeks leave of this Court to amend its complaint to allege the full nature and extent of said monetary damages, if and when, and to the extent the damages are ascertained.

COUNT III
LIKELIHOOD OF INJURY TO BUSINESS REPUTATION OR DILUTION
(NY Gen. Bus. Law § 360-l)

68. Dexter repeats and realleges each allegation contained in the prior paragraphs hereto, and the same are incorporated herein and made a part hereof.

69. The forgoing acts of Mercer have created and will create a likelihood of injury to the public image and business reputation of Dexter.

70. The forgoing acts of Mercer have created and will create a likelihood of dilution of Dexter's Trademarks.

71. Dexter's Trademarks are extremely strong, inherently strong and distinctive, and have acquired distinctiveness and a secondary meaning.

72. Mercer appropriated Dexter's Trademarks by offering for sale and selling the Infringing Products, which are confusingly and substantially similar to Dexter's Trademarks and Registrations.

73. The forgoing acts of Mercer will create a likelihood of dilution by blurring, in that Mercer's offering for sale and sale of the Infringing Products will cause Dexter's Trademarks to lose their ability to serve as a unique identifier of Dexter's Goods and services.

74. Upon information and belief, Dexter's Goods and services are of superior quality as compared to Mercer's goods and services and thus, the forgoing acts of Mercer will create a

likelihood of dilution by tarnishment, in that Mercer's Infringing Products will be associated with Dexter and Dexter's Trademarks.

75. Based on the foregoing, Mercer has violated New York Gen. Bus. Law § 360-l, for which Dexter is entitled to injunctive relief.

COUNT IV
USE OF NAME WITH INTENT TO DECEIVE
(NY Gen. Bus. Law § 133)

76. Dexter repeats and realleges each allegation contained in the prior paragraphs hereto, and the same are incorporated herein and made a part hereof.

77. Mercer offered for sale and sold the Infringing Products in commerce.

78. Upon information and belief, Mercer was aware of Dexter, Dexter's Goods and Dexter's Trademarks prior to the time Mercer commenced offering for sale and selling the Infringing Products.

79. Upon information and belief, based upon, without limitation, the striking and confusing similarity between the Trademarks and the Infringing Handle Designs, the proximity of the Dexter Goods and the Infringing Products, and Mercer's prior knowledge of Dexter, Dexter's Goods and Dexter's Trademarks, Mercer adopted, offers for sale and sells the Infringing Products with the intent of causing confusion among consumers and with the purpose of benefitting from Dexter's reputation and goodwill.

80. Upon information and belief, Mercer is offering for sale and selling the Infringing Products in bad faith.

81. Upon information and belief, Mercer is offering for sale and selling the Infringing Products with the intent to cause confusion and to deceive the public.

82. Mercer's offering for sale and sale of the Second Infringing Products has created and is creating a likelihood of confusion.

83. The foregoing acts of Mercer constitute a violation of New York Gen. Bus. Law. § 133, for which Dexter is entitled to injunctive relief.

COUNT V
COMMON LAW INFRINGEMENT AND UNFAIR COMPETITION

84. Dexter repeats and realleges each allegation contained in the prior paragraphs hereto, and the same are incorporated herein and made a part hereof.

85. Upon information and belief, the acts of Mercer have been committed willfully, intentionally, and in bad faith.

86. Upon information and belief, Mercer intentionally appropriated Dexter's Trademarks with the intent of causing confusion, mistake and deception as to the source of its Infringing Products and Infringing Designs, with the intent to palm-off its Infringing Products as those of Dexter's and to misappropriate the reputations, efforts and good will of Dexter.

87. Mercer's acts have created a likelihood of confusion.

88. The acts of Mercer, including Mercer's offering for sale and sale of the Infringing Products, constitute trademark infringement, in violation of the common law of the State of New York.

89. The acts of Mercer, including Mercer's offering for sale and sale of the Infringing Products, constitute unfair competition, in violation of the common law of the State of New York.

90. The foregoing acts of Mercer have injured and will continue to injure Dexter, by depriving it of sales of its genuine goods and services, by injuring its business reputation, and by

passing off Mercer's Infringing Products as Dexter's Goods, all in violation of the common law of the State of New York.

91. Mercer's acts have caused irreparable harm and damage to Dexter and have caused Dexter monetary damage in an amount thus far not determined, for which Dexter is entitled to its actual damages, Mercer's profits, punitive damages, attorneys' fees and costs.

92. Dexter has no adequate remedy at law.

WHEREFORE, Dexter demands judgment against Mercer as follows:

A. That Mercer's conduct serves to infringe Dexter's registered Trademarks, in violation of Lanham Act § 32, 15 U.S.C. § 1114.

B. That Mercer's conduct serves to infringe Dexter's Trademarks, falsely designate the origin of Mercer's goods and services, falsely describe such goods, and unfairly compete with Dexter, all in violation of Lanham Act § 43(a), 15 U.S.C. § 1125.

C. That Mercers' conduct will create a likelihood of dilution and injury to Dexter's business reputation in violation of New York Gen. Bus. Law § 360-l.

D. That Mercer offered for sale and sold the Second Infringing Products with the intent to cause confusion and to deceive the public in violation of New York Gen. Bus. Law. § 133.

E. That Mercer has injured Dexter by depriving it of sales of its genuine goods and services, by injuring its business reputation, and by passing off Mercer's Second Infringing Goods as Dexter's Goods, all in violation of the common law of the State of New York.

F. That Mercer and its agents, officers, directors, servants, employees, attorneys, their successors and assigns, and all others in active concert or participation with Mercer be preliminarily and permanently enjoined from directly or indirectly:

i. Using Dexter's Trademarks, or any other marks which are similar to or are colorable imitations of Dexter's Trademarks, alone or as a part of, or together with, any other designs, word or words, trademark, service mark, trade name, trade dress or other business or commercial designation or any logo, symbol or design;

ii. Committing any act which, in and of itself, or from the manner or under the circumstances in which it is done amounts to false designation of origin, false description or false representation of Mercer's goods and services; and

iii. Otherwise unfairly competing with Dexter or committing dilution or infringement of Dexter's rights.

G. That the Court issue an Order directing Mercer to file with the Court and serve on Dexter, within thirty (30) days after the service on Mercer of such injunctions, a report in writing and under oath, setting forth in detail the manner and form in which Mercer have complied with the injunction.

H. That the Court award judgment in favor of Dexter for the damages sustained by Dexter and the profits made by Mercer as a result of Mercer's wrongful conduct.

I. That the Court award judgment in favor of Dexter in the amount of treble damages.

J. That the Court award judgment against Mercer for the full costs of this action, including Dexter's reasonable attorneys' fees.

K. That the Court award to Dexter punitive damages sufficient to deter Mercer from committing such willful acts of infringement in the future.

L. That this Court require a full and complete accounting of all monies received by Mercer as a result of the sales of the Second Infringing Products.

M. For interest on all amounts found to be due to Dexter from Mercer, at the prevailing rate, from the date said amounts or any part thereof became or become due.

N. That the Court require Mercer to notify its commercial associates, suppliers and customers of said Order.

O. That the Court order such other, further and different relief as the nature of this action may require and that the Court may deem just and proper.

P. That the Court retain jurisdiction of this action for the purpose of enabling Dexter to apply to the Court, at any time, for such further orders and directions as may be necessary or appropriate for the interpretation or execution of any order entered in this action, for the modification of any such order, for the enforcement or compliance therewith and for the punishment of any violations thereof.

JURY TRIAL DEMANED

Plaintiff, Dexter, hereby demands a jury trial of all issues so triable.

Dated: Scarsdale, New York
February 28, 2017

Respectfully submitted,

LACKENBACH SIEGEL LLP

By: *_/s/ Jeffrey M. Rollings_*

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